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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/575,139	05/23/2000	Paul Lapstun	NPA019US	9190

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BALMAIN, 2041
AUSTRALIA

EXAMINER

NGUYEN, MADELEINE ANH VINH

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 05/24/2002

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/575,139

Applicant(s)

LAPSTUN ET AL.

Examiner

Madeleine AV Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-49 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 25-49 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

This communications is responsive to amendment filed on February 28, 2002.

Applicant cancels claims 1-24, and adds new claims 25-49.

Claim Objections

1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 1-15 have been renumbered as 25-49 respectively.

Response to Applicant's Remarks

Applicant remarks that Sekiya does not disclose the use of coded data on the page for the capture of user generated data but uses optical scanning, and Sekiya does not generate data that combine form identity and sensor position and which is based at least partially on coded data sensed in the vicinity of the sensing device.

It is noted that character coded data is considered as coded data in Sekiya. Sekiya discloses recognition section 2 which receives image information from scanning section 4 to recognize character information at a character area on an input manuscript. Character codes of

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the characters recognized are applied through a data line 13 to CPU 16 (col. 2, lines 29-41).

Sekiya further teaches a buffer area temporarily stores image formation obtained in scanning section 4. The buffer area stores several files of character/image information including a character area and an image area of slips, other areas store format numbers (Ids) representing formats of slips to be processed, ID tables representing character position (or coordinates) in the character area on the slips (col. 4, lines 13-33). Thus the sensing device (OCR, Fig.1) sends interaction data indicative of an identity of the form and a position of the form. Since Sekiya does not specifically mention that the position of coordinates in the character area of the form is also a position of the sending device relative to the area, Kurogane et al is combine with Sekiya to support that by disclosing a picture image processing system with a scanner (IIT 40) for reading a stack of original documents as well as job control sheet (Fig.4) including sheet detecting marks 101a-101d arranged in it four corners as interaction data indicative of position of the sensing device relative to the area of the sheet.

The rejection of claims 25-49 is followed.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 25-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sekiya et al (US Patent No. 4,566,127) in view of Kurogane et al (US Patent No. 5,126,858).

Concerning claim 36, Sekiya discloses a system (Figs.1 and 2) to enable a user to compose and deliver a message by facsimile, utilizing a form printed on at least one surface (Fig.10), the form including information relating to the user and at least one area for the user to enter the message, the at least one surface having coded data indicative of an identity of the form and of the at least one area, the system including a computer system (Fig.1) which causes the form to be provided to the user; receives the interaction data from a sensing device (OCR), the interaction data indicative of an identity of the form (ID, Fig.10) and ID tables representing character positions in the character area on the slips (col. 4, lines 23-33), and captures the message to be transmitted to a designated recipient address by facsimile delivery (col. 3, lines 31-40).

Sekiya does not directly teach that the interaction data indicative of a position of the sensing device relative to the area. Kurogane et al discloses a picture image processing system with a scanner (IIT 40) for reading a stack of original documents as well as job control sheet (Fig.4) including sheet detecting marks 101a-101d arranged in its four corners as interaction data indicative of position of the sensing device relative to the area of the sheet. The form in Fig.4 includes sheet detecting marks 101a-101d, information relating to the user and one area for the user to enter the message. The sheet detecting marks 101a-101d represent different attributes of the sheet with entry columns for checking the attributes of a job provided on the inner side of these marks. The sheet detecting marks have an attribute with different information indicating the scanning direction, such as the vertical forward direction, the vertical reverse direction, the

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horizontal forward direction and the horizontal reverse direction (col. 4, line 14 – col.5, line 18).

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to combine the teaching of scanning form sheet Kurogane et al to the sensing form sheet in Sekiya since both Sekiya and Kurogane et al teaches the reading of different form with interaction data indicative of and identity and position of the form in order for the computer system recognize the coded data in the vicinity of the position of the form.

Concerning claims 37-49, Sekiya further teaches that the computer system causes the form to be provided to the user in response to receiving a request for the form; the computer system causes both the form and the character coded data to be printed onto one surface simultaneously; the computer is adapted to delivery the message with a reply number, a fax application (ID code) for receiving and formatting the message for transmission, the fax application further serving to allocate the reply of the reception request (col. 4, lines 24-33); the coded data serves to identify the form and at least one point of the form (col. 5, line 13 - col. 6, line 24); the computer system is adapted to receive movement data regarding the movement of the sensing device relative to the coded data, on order to capture the message (col. 3, line 50 - col. 4, line 2); the sensing device senses its own movement relative to the document using the coded data (col. 2, lines 36-53; col. 3, line 50 - col. 4, line 33); the document is printed on demand by recording 3 wherein the printer is arrange to print the coded data at the same time as printing the document on a surface defining structure (Fig.10; col. 2, lines 46-50; col. 6, line 42 - col. 7, line 8); the system include a database (5) for keeping a retrievable record of each document which are retrievable by using its identity as included in its coded data (col. 4, lines

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13-33; col. 5, line 44 - col. 6, line 38); a sensing device (OCR, Fig. 1); a printer (3) for printing a form with coded data and the form.

Concerning claims 44, Kurogane further teaches the sensing device includes a marking nib.

Concerning claims 46 and 49, Sekiya and Kurogane do not teach that the coded data is substantially invisible to the average unaided human eye and the printer includes a binding means for binding the printed form in the event the form includes a plurality of pages. However, it was commonly known in the art that the coded data is invisible data for security, for instance, the coded data is read under infrared light, and the printer includes a binding means for binding the printed form. It would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of well known in the art to modify the system in Sekiya being able to read coded data which is invisible to the average unaided human eye, and the printer in Sekiya having a binding means since Sekiya teaches the cases of unrecognizable reject-characters to be key corrected, and the case of printing a plurality of pages.

Claims 25-35 are method claims of apparatus claims 36-49. Claims 25-35 are rejected as claims 36-49 respectively.

Conclusion

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Baran (US Patent No. 5,247,591) discloses a method and apparatus for the primary and secondary routing of fax messages using hand printed characters.

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b. Masuzaki et al (US Patent No. 5,179,649) teaches a method for generating title information entry format and method for filing images in image filing device.

4. Applicant's arguments with respect to claims 25-49 have been considered but are moot in view of the new ground(s) of rejection.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Madeleine AV Nguyen whose telephone number is 703 305-4860. The examiner can normally be reached on 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on 703 305-4712. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872-9314 for regular communications and 703 872-9314 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305-4700.



Madeleine AV Nguyen
Primary Examiner
Art Unit 2622

AV
May 14, 2002